

Appl. No. 09/158,728

Amdt. Dated 2/11/2008

Response to Office action dated October 9, 2007

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The below-signed counsel for Applicants and Applicants' technical representative, Dr. Ugolick, thank Examiner Chevalier for the courtesies extended to them during their telephone interview of January 31, 2008. During that interview, claims 590 and 591 and U.S. Patent 5,462,488 (McKillip) were discussed. Referring to that telephone interview and the Examiner's written summary thereof, support for "without adhesive" is found in original claim 32 and in the drawings. She said that the drawings show that adhesive is not provided between the film layer and the continuous sheet. She also said that the film layer of the subject application is "directly adjacent" to the continuous sheet and that phraseology such as "directly adjacent" would patentably distinguish over McKillip which includes a layer between the film layer and the further sheet.

Examiner Chevalier further stated that McKillip is not "free of adhesive between the film layer and the continuous sheet" because of the presence of the deadener (which argument was not provided in the Final Rejection). Counsel and Dr. Ugolick disagreed for reasons which will be explained in detail later in this Remarks section.

The Final Rejection

In the above-mentioned Final Rejection, claims 584, 591, 624, 660 and 726 were objected to as being of improper dependent form for failing to further limit a previous claim; claims 548-589, 590-628, 663-729, 739, and 733 were rejected as failing to comply with the written description requirement; claim 591 was rejected for being indefinite; claims 548-571-577, 578, 580-611, 617, 618, 620-649, 655, 656, 658-680, 683, 684 and 686 were rejected over McKillip in view of U.S. Patent 5,407,718 (Popat); claims 572, 573, 612, 613, 650, 651, 681, 682, 715 and 716 were rejected over McKillip in view of Popat and further in view of U.S. Patent 4,704,317 (Hickenbotham et al.);

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claims 574-576, 614-616, 652-654, 717 and 718 were rejected over McKillip in view of Popat and further in view of U.S. Patent 5,198,275 (Klein); and claims 579, 619, 657, 685 and 721 were rejected over McKillip in view of Popat and further in view of U.S. Patent 5,842,722 (Carlson).

Applicants appreciate the detail in the rejections which the Examiner provided in her sixty-two page Final Rejection.

In response thereto, paragraphs [0052] and [0073] of the specification have been amended, claims 548, 588, 629, 647, 664, 681, 693, 694, 695 and 730 have been amended, and claims 568, 569, 585, 587, 696 and 733 have been cancelled without prejudice of disclaimer. No new matter has been added, Applicants respectfully contend.

"Free of Adhesive between the Film and the Continuous Sheet"

In paragraph 10 of the Office Action, claim 590 was rejected because the limitation "the laminate sheet construction being free of adhesive between the film and the continuous sheet" was considered to be new matter. Applicants respectfully disagree with this rejection. FIGS. 6, 9 and 25 show the film and the continuous sheet directly abutting one another with no material (e.g., adhesive) between them. Referring to the second full paragraph on page 3 of the application as filed, (a) the sheet construction separates at the film-liner interface, (b) the LPDE layer is extrusion coated on the densified bleached kraft paper liner to form a film-coated liner sheet, (c) "dry peel" (which means no PSA), and (d) a film forming polymer coated onto a liner stock. In the second full paragraph on page 4, it says that the sheet "delaminates at the film-liner sheet interface." The last paragraph of page 8 when referring to FIG. 4 says that the LDPE layer 204 is extrusion coated onto a liner sheet 208. At the top of page 9, it says that the construction delaminates at the LDPE - liner sheet interface, and FIG. 5 shows the business card being peeled directly off of the liner. Original claim 32 says that the liner strips are bonded "without adhesive." Original claim 6 and the abstract state that the film layer is extrusion coated on the liner sheet.

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During the above-mentioned telephone interview the Examiner said that the McKillip sheet is not free of adhesive between the film layer and the continuous sheet because of the presence of the deadener. McKillip in the first and second full paragraphs of column 9 discusses the application of a deadener 70 to the bottom surface 45 of the second layer of material 24 prior to the attachment of the laminate means 26. Since the second layer of material 24 of McKillip corresponds to the facestock of the present claims, according to the Examiner, the deadener 70 is not between the film layer and the continuous sheet. Rather, the deadener is between the facestock and the adhesive 28. In other words, the deadener is not provided to deaden portions of the adhesive 28 but rather the adhesive 30. Thus, the deadener 70 does not deaden adhesive 28 as the Examiner contended in the telephone interview. Further, even if for the sake of argument the deadener were so positioned it would not remove the adhesive layer 28. That is, McKillip would still not be "free of adhesive between the film layer and the continuous sheet." Accordingly, claims 549 and 590 are patentable over McKillip.

The objections to claims 549 and 590-628 wherein the Examiner contended that the limitation "the laminate sheet construction being free of adhesive between the film and the continuous sheet" is not in the original application disclosure is respectfully traversed, as discussed above and further discussed below. The drawings form part of the original disclosure, and drawing FIGS. 6, 9, 23, 24, 26 and 28, for example, disclose this limitation. In fact, the Examiner admitted in the above-discussed telephone interview that the drawings "show that adhesive is not provided between the film layer and the continuous sheet" and that the film layer is "directly adjacent to" the continuous sheet. The Examiner also said that the drawings do not show that "adhesive is always excluded" [between the film layer and the continuous sheet] (emphasis added). However, being "always excluded" is irrelevant for the present patentability discussion, Applicants respectfully contend, because a claim does not have to be supported by all embodiments disclosed in an application, but only by one embodiment. The specification has been amended to specifically include the words that the sheet can thus be free of adhesive between the film layer and the liner.

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Pursuant to MPEP 2163.06 III, "The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)."

Continuous Sheet is Directly Adjacent to the Film Layer

As mentioned above relative to the telephone interview, the Examiner said that McKillip does not disclose nor would it have been obvious to modify McKillip such that the continuous sheet is directly adjacent to the film layer. Thus, claims 548 and 629 are patentable over McKillip.

Continuous Sheet Bonded to the Film Layer Without Adhesive

As discussed above, the Examiner said that the limitation that the continuous sheet is bonded to the film layer without adhesive is supported by original claim 32 and further that McKillip does not disclose this limitation nor would it have been obvious to so modify McKillip. Thus, claims 588, 664 and 730 are patentable over McKillip.

Dependent Claim 591 is Consistent with Independent Claim 590

Independent claim 590 will now be discussed. Disclosed in FIGS. 6, 9, 23 and 24 (from top to bottom) are the facestock sheet 212, the adhesive 216, the film layer 204, the continuous sheet 208 (e.g., liner sheet or carrier sheet), and the through-cut line 240. The "facestock sheet construction" can include the facestock sheet 212, adhesive 216, and the film layer 204, and is shown for example by reference numeral 220 in FIG. 6. The "laminate sheet construction" can thus include the facestock sheet construction (220) with the continuous sheet 208 bonded (for example) directly to the film layer 204. (The film layer 204 can be extrusion coated directly onto the continuous sheet 220.) When the (printed) business card is then peeled off of the laminate sheet construction, the laminate sheet construction because of its structural properties delaminates at the interface of the

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continuous sheet and the film layer.

In paragraphs 5 and 13 of the Office Action, it was found that dependent claim 591 is inconsistent with or contradicts independent claim 590. Applicants respectfully disagree. This is because referring to the paragraph above, the adhesive is between the facestock sheet and the film layer and not between the film layer and the continuous sheet. Thus, the objection to claim 591 should be withdrawn.

Delaminates at the Interface of the Film Layer and the Continuous Sheet

Illustrated in FIG. 6 of McKillip (from top to bottom) are a facestock sheet 24, a laminate (film) 26, adhesive 28 and a bottom layer (continuous sheet) 22. The (card edge) cut line 50 extends from the facestock sheet through the laminate. (Adhesive 53 between the facestock sheet 24 and the laminate 26 is not shown in FIG. 6.) The sheet is structured such that when the printed card is peeled off, the sheet delaminates between the adhesive 28 and the laminate 26. Thus, the surface from which the card is removed has adhesive (28) on it. This surface is the dotted surface underneath the card in FIG. 7. The last paragraph of claim 590 says: "the laminate sheet construction being free of adhesive between the film layer and the continuous sheet." McKillip discloses that there is adhesive (adhesive 28) between the laminate (film) 26 and the sheet 22. Additionally, it would not have been obvious to remove adhesive 28 from McKillip; and in particular there is no teaching/suggestion/motivation in Popat for removing the adhesive 28 from McKillip nor is one provided in the final Office Action.

The present business card sheet construction can be constructed such that when a peeling force is applied to it, it delaminates at the interface of the film layer and the continuous sheet. For example, paragraph [0052] of the present application as published says that "[t]he PSA layer 216 need only secure the facestock sheet 212 to the LDPE layer 204 of the dry release base material or liner sheet 208, such that the overall dry laminate facestock construction 224 delaminates at the LDPE-liner sheet interface when a user seeks to peel away the liner, and not at a surface of the

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facestock sheet 212.” Paragraph [0008] says: “The sheet construction (which also includes a facestock bonded to the film forming polymer) separates at the film-liner interface rather than the facestock-film interface, when the final construction is subjected to a peeling force.” Paragraph [0011] says: “In other words, the adhesive layer securely bonds the facestock sheet to the LPDE film layer on the liner sheet. It bonds it such that the overall sheet construction separates or delaminates at the film-liner sheet interface, when the user peels the printed business cards and liner strips apart.” Thus, the feature in is a structural feature and not a functional feature, and is supported in the application as filed.

Further, the delamination at the interface of the film layer and the continuous sheet is not disclosed by or a “latent property” of McKillip as the Examiner contends on page 15 of the Final Rejection. There is an adhesive layer 28 between the film layer and the continuous sheet of McKillip, as discussed in detail above. Thus, there is no film layer-continuous sheet interface in McKillip. Additionally, the delamination in McKillip is at the interface of the film layer and the adhesive layer. Thus, claims 548, 629, 693, 694, 695 and 729 are patentable over McKillip.

Printable Business Card Sheet is “Free of Tractor-Feed Perforations”

An example of “tractor-feed perforations” is shown in McKillip by holes 91 in FIGS. 6, 7 and 11, and are provided to cooperate with “a tractor feed mechanism typically used in association with printing apparatus.” (Col. 3, lines 13-15.) “[T]he holes serve to facilitate use of integrated card and business form assembly 20 on conventional business equipment which may require such holes for transmission via a tractor feed mechanism.” (Col. 9, lines 3-5). Referring to FIG. 12 and the explanatory portions of the specification, the embodiment disclosed therein is constructed to be sheet-fed into and through a printed or copier and not transmitted through business equipment using a tractor feed mechanism. Thus the sheets as illustrated in FIG. 12 (and other figures) are depicted as

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being free of tractor-feed perforations. The specification has accordingly been amended. Thus, the rejections/objections of claims 589, 628, 663, 664 and 739 should be withdrawn.

Cards Can Be "Blank" (Free of Visible Indicia)

Claims 548 and 773 have been amended to replace "free of visible indicia" with "blank." The word "blank" can be found in paragraphs [0009] and [0010] and in the Abstract of the subject application. Support for "blank" (as well as for "free of visible indicia") is also found in original drawing FIGS. 8, 11 and 27, especially when compared with FIGS. 4, 5 and 12, which show cards with printing on them. Thus, the objections to those two claims should be withdrawn.

The Independent and Dependent Claims

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in or obvious from the cited references. Thus, the claims are also patentable for additional reasons, for example as set forth in Applicants' last Amendment.

Conclusions

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is respectfully solicited.


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The Examiner is invited to call the undersigned counsel for Applicants at counsel's new phone number ((805) 230-1350 ext 244) to answer any questions or to discuss steps necessary for placing the subject application in condition for allowance.

Respectfully submitted,

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